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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/030,149
Filing Date: January 28, 2002
Appellant(s): YANO ET AL.

George N. Stevens (Reg. # 36,938)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/15/2007 appealing from the Office action mailed 10/15/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

Note: Appellant's representative claimed to be including claim 9 in the Summary of Claimed Subject Matter, "... claims 1-3,8,***9,*** and 13-21..." however, claim 9 has been canceled. As there was a previous problem with a timely response to the instant Appeal Brief, the examiner is treating this as a typographical error, therefore, it will be ignored.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,622,129	Whitworth	9-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-8,10-23 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

As to claims 1-3,8,9,13-21, there are no initiations that would enable one of ordinary skill in the to be able to know how to combine the factors described.

For instance, in claim 1 is the limitation, "...using data concerning resold vehicles such as..." without describing how to use the data. Further in claim 1 is the limitation, "...a first step with extracts... a second step which extracts... a third step which obtains multi-regression equation... for estimating..." There is no way to know what the "multi-regression equation" is or how to obtain it or how to use it to estimate a price.

All independent claims similarly lack enablement.

Claims 4-7,10-12, 22 and 23 are rejected as depending from rejected claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 and 13-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 1-3, and 13-20, while the preamble to these claims clearly states they are directed toward a "system" (i.e. an apparatus). However, there is no structure to the system and further, the limitations are directed toward what appears to be a method and not a system. It is therefore impossible to know the scope of the claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 8, 13-19,21, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by US PAT 6,622,129 to Whitworth.

As to claims 8 and 13, as best understood, Whitworth discloses a method, system and program used to determine a vehicle resold value (title), using such criteria as model, optional equipment, model year (fig 2). Whitworth further teaches a using contract (lease).

Whitworth further teaches using a storage medium (fig 1). This would be used for profit and loss analysis (title).

As to claim 14, as best understood, Whitworth uses a table to correlate data (figs 5-7).

As to claims 15-19, as best understood, Whitworth uses a contract length or "assumption using period) (lease terms).

As to claim 21, as best understood, Whitworth teaches a remaining value calculation (col U in fig 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-7,10-12, 20,22 and 23, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over US PAT 6,622,129 to Whitworth.

Whitworth discloses a method, system and program used to determine a vehicle resold value (title), using such criteria as model, optional equipment, model year (fig 2). Whitworth further teaches a using contract (lease).

As to claims 1,2, and 23, as best understood, Whitworth does not teach a 'multi-regression equation. It would have been obvious to one of ordinary skill in the art to use a multi-regression equation to ensure the result is accurate. The result is used to analyze profit and loss

As to claim 3, as best understood, Whitworth does not specifically teach a correlation equation. It would have been obvious to one of ordinary skill in the art to use a correlation equation as Whitworth is shown to correlate data using equations (fig 3).

As to claims 4 and 10, as best understood, Whitworth does not teach using mileage from the "actually using period" and storing it. It would have been obvious to one of ordinary skill in the use actual mileage, and to store it, as it is very well known in the art for mileage to affect the value of an automobile.

As to claims 5 and 11, as best understood, Whitworth uses sedan type (col D in fig 5).

As to claim 6, the information is shown to be outputted (figs 5-7).

As to claim 7, the information is outputted at an arbitrary time (whenever it is ready).

As to claim 12, Whitworth discloses a display (as is inherent in a computer).

As to claim 20, as best understood, Whitworth does not, however, specifically using standard deviation to perfect the data. It would have been obvious to one of ordinary skill in the art to use standard deviation as this is well know to be useful in refining numbers for accuracy.

As to claim 22, as best understood, Whitworth does not teach a secondary retrieval program, Whitworth does, however, teach extracting this information (figs 5-7). Therefore it would have been obvious to one of ordinary skill in the art to use a secondary program to ensure the data is correct.

(10) Response to Argument

As to arguments in relation to the rejection under 35 U.S.C.112, first paragraph, appellant points out which values "may be" used to determine an unknown "multi-regression" formula, none of which values are delineated and thus, one of ordinary skill in the art would not know which factors to use nor which "multi-regression" equation to obtain. As to arguments in relation to which factors to use to determine the vehicle sold price, there is no way to know which factors to use nor how to combine them to achieve this result. Which factors are used and how to combine them would be necessary for

one of ordinary skill in the art to be able to make and/or use the instant invention. As is discussed in the above rejection, the examiner did find a reference which met the limitations as best understood. Which rejection was included in the interests of compact prosecution.

As to arguments in relation to the rejection under 35 U.S.C.112, second paragraph, as appellant's representative notes, the *system* claims merely recite *method* steps without structure for performing the steps. Thereby confusing different statutory types of claims (apparatus and method) and thereby making the scope of the claims unclear and indefinite as these limitations are given different patentable weight in the different statutory classes of claims.

As to arguments in relation to claims 8 and 21, the limitations, as quoted, are included in alternative form ("or") and therefore, the rejection is properly under 35 U.S.C. 102. As the limitations are in the alternative, not all must be found, so yes, the examiner can pick and choose limitations claimed in the alternative.

As to arguments in relation to claims 1 and 2, as appellant has not described any multi-regression equation nor how to obtain it and indeed, has refused to do so after each rejection that states that this is neither enabled nor clear, the examiner is confused as to how appellant's representative can claim that this would not be obvious. As the invention is not drawn toward multi-regression equations but merely using them, and as they are not described, the appellant is implicitly agreeing that they are old and well known and therefore, the rejection is proper.

As to arguments in relation to claim 3, as discussed previously, the residual value is the price the company deems the vehicle will be worth (resold price), thereby meeting the limitations as claimed and understood. Further, as the limitations are in the alternative, not all must be found, so yes, the examiner can pick and choose limitations claimed in the alternative. For instance, if a car is valued by "either the miles or the options", the examiner only must find one of these, miles or options.

As to arguments in relation to claim 13, it was included in the listing of claims in the rejection under 35 U.S.C. 103 (a), however, due to a typographical error it was not specifically listed, however, its limitation were rejection in relation to other claims.

As to arguments in relation to claim 14, yes, the examiner may pick and choose among limitations included in the alternative.

As to arguments in relation to claims 15,16 and 18, again, not all limitations included in the alternative must be addressed.

As to arguments in relation to claim 17, again, not all limitations included in the alternative must be addressed.

As to arguments in relation to claim 19, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

As to arguments in relation to claim 20, proper traversal of Official Notice (implicit in "well known") would include an assertion that the limitation is not old and well known, appellant has not done so.

As claims 4-7,10-12 ,22 and 23 were not included the summary of claimed subject matter, these arguments will not be addressed.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

MF

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